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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,533	09/27/2006	Yoichiro Yamanaka	06686/HG	8114
1933 7590 09/15/2008 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER JACKSON, MONIQUE R				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/594,533

**Applicant(s)**

YAMANAKA ET AL.

**Examiner**

Monique R. Jackson

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 7/19/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Objections***

1. Claims 12-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 12-13 have not been further treated on the merits. (Note: "any of claims 1 to 11" is not proper alternative format, however, "any one of claims 1 to 11" is proper.)

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 includes a parenthetical expression at line 13 wherein it is unclear whether the term within the parenthesis is meant to be part of the claimed invention or not.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (USPN 6,277,455). Shimizu et al teach a polyester laminate film free of whitening upon retorting, comprising plural polyester layers, which comprises one surface layer comprising

a polyester A and a lubricant in a proportion of 1-5 wt % and the other surface layer B comprising a polyester wherein 5-15 mol % of the entire acid component is a dimer acid component; and the laminate film is suitable for laminating to a metal plate for producing food containers and beverage cans (Abstract.) The polyester composition A has a cyclic trimer content of preferably not more than 0.7wt%, more preferably not more than 0.5 wt%, so as to suppress the possible precipitation of oligomer in the film and migration of the oligomer into the beverages thereby degrading the taste and flavor of the container content; wherein the polyester may be polyethylene terephthalate copolymer and polybutyrene terephthalate copolymer with other copolymer components including those as listed such as a cyclohexane dimethanol (Col. 4, line 23-Col. 5, line 12.) Shimizu et al teach that the polyester film may be formed on one or both sides of a metal sheet for producing a food container wherein additives may be incorporated based upon whether the film is on the inner or outer wall of the container (Col. 5, lines 23-32.) The polyester B can be formed from glycol components and dicarboxylic acid components as recited in Col. 6, including 5-sodium sulfoisophthalate as well as mixtures thereof, wherein terephthalic acid and ethylene glycol being preferred (*which would produce a hydrophilic copolyester as claimed*; Col. 6, lines 28-54.) Shimizu et al teach that the film may be coextruded and biaxially oriented or unoriented; and that both A and B layers can have a thickness of 3-20 microns (Col. 7, lines 10-55.) Though Shimizu et al do not specifically teach the mol% of the glycol components in the upper layer A as instantly claimed or the mol% of the dicarboxylic acid components of the lower layer B as instantly claimed, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any of the glycols or dicarboxylic acid components taught by Shimizu et al in any amounts, utilizing routine experimentation to

determine the optimum amounts of each to provide the desired mechanical properties for a particular end use. Further, though Shimizu et al only specifically teach the cyclic trimer content of the polyester A composition, one skilled in the art would have been motivated to also limit the cyclic trimer content in the composition B to prevent migration from layer B as well into the container contents. Lastly, though Shimizu et al do not specifically teach the claimed properties of the layers, such as the plane orientation factor, crystal size, relaxation time, and double refractive zone, it would have been obvious to one having ordinary skill in the art at the time of the invention that these properties would have flown naturally from the teachings of Shimizu et al and/or that these properties are known result-effective variables to be controlled in the art, affecting the mechanical properties of the polyester films, and could be easily determined by the skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/  
Primary Examiner, Art Unit 1794  
September 13, 2008